by that reference." *Atlas Powder Co. v. E.I. duPont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

The present invention is directed to a pattern-coated film that has matched optical properties of the uncoated portions and the coated portions. The two portions are visually indistinguishable regardless of the size or thickness of the coating.

In Butler et al., the coating patterns provide controled release surfaces for tapes, image receptors, and the like. There is no disclosure of how to create a patterned coating that will provide a visually uniform surface. The coating pattern is not particularly uniform and thus there is no disclosure as to how to control the patterned coating to produce and article as claimed by the present invention. According to Butler, "pattern" means an inhomogeneous coating that varies in thickness, spacial resolution and material composition across and down web...."

As the Examiner has stated, Butler et al. broadly state a great variety of things that possibly could be done with the coating method to make a film as the manufacturer desires. Someone may, possibly with all of the variations obtain a film that has portions that are visually indistinguishable. But there is really no recognition that this would be a desirable trait and that from the myriad possibilities, one might accidentally fall upon how to do this coating. However, Butler et al. fail to specifically identify how to make a film that render the different portions of the film visually indistinguishable.

Applicants respectfully suggest that such an accidental or unwitting duplication in the reference fails to anticipate the present invention. *See* 198 U.S.P.Q. 344 (CCPA 1978).

Therefore, Applicants respectfully submit that Butler et al. fails to anticipate claims 1, 3 and 4 and respectfully requests the Examiner withdraw all such rejections.

Rejection under 35 U.S.C. § 103(a)

Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Butler et al. in view of Frognet et al. (U.S. 5,178,942).

The Examiner has combined Butler et al. (teaching a microscopically textured glossy coated film) with Frognet et al., which teaches the use of amorphous silica and that it is particularly useful as an antiblocking addition in a film.

Applicants respectfully submit that when claimed subject matter has been rejected as unpatentable in view of a combination of references, a proper analysis of 35 U.S.C. §

103 requires consideration of two factors (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed article, and (2) whether the prior art would also reveal that, is so making or carrying out, those of rdinary skill in the art would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be found in the art, not in Appellants' disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

Frognet et al. teach the use of a silica in the film, rather than a coating on the film. In view of such teaching, it is unclear how Frognet et al. cure the deficiency of Butler, which also fails to teach how to obtain a film with portions that visually indistinguishable. Thus the combination must fail and the rejection must be withdrawn as being clearly erroneous.

Therefore Applicants respectfully request the Examiner withdraw all 35 U.S.C. § 103(a) rejections from Claims 1-4 based on the combination of Butler et al. and Frognet et al.

Claims 5-14 are rejected under 35 U.S.C. § 103(a) are being unpatentable over Butler et al. in view of Blackwell et al. (US 5,401,547).

As stated above, the combination must take into consideration and provide both the suggestion to make the modifications to make the claimed article and that there was a reasonable expectation of success.

Again, because Butler et al. fail to teach how to obtain a film with portions that visually indistinguishable and Blackwell et al. gives no motivation for combination its teaching with Butler et al., this combination also must fail and the rejection must be withdrawn as being clearly erroneous.

Therefore Applicants respectfully request the Examiner withdraw all 35 U.S.C. § 103(a) rejections from Claims 5-14 based on the combination of Butler et al. and Blackwell et al.

Applicants respectfully suggest this paper is fully responsive to the Office action and the remarks and amendments have resolved the Examiner's outstanding objections and rejections. However, if after fully considering Applicants' response, there are issues remaining, Applicants request the Examiner telephone the undersigned to timely resolve any remaining issues.

Please charge any fees that may be associated with this paper to Deposit Account No. 13-3723.

Respectfully Submitted By:

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